UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,045	09/09/2003	Siegfried Franke	HOE-776	3269

20028 7590 05/12/2006

Lipsitz & McAllister, LLC
755 MAIN STREET
MONROE, CT 06468

EXAMINER	
CHONG, YONG SOO	
ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 05/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/659,045	FRANKE ET AL.	
	Examiner	Art Unit	
	Yong S. Chong	1617	

The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 March 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) *8-11* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Status of the Application

This Office Action is in response to applicant's arguments filed on 3/17/2006. Claims 8-11 have been withdrawn. Claim 1 has been amended. Claims 1-7 are pending and are examined herein. Applicant's arguments have been fully considered but found not persuasive. The 35 USC 103(a) rejection is repeated below and maintained for reasons of record.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franke et al. (DD 299458, relying on 117CA:106200 as an English language abstract) in view of Wolthers et al. (DD 301726, relying on 120CA:99206 as an English language abstract), Hill et al. (USPN 6723349) and Fuchs et al. (USPN 4284645).

Franke et al. teaches a detoxicant comprising 0.5-2.6M sodium; 10-60% of an amino alcohol, preferably dimethylaminoethanol; 0-20% of an alcohol; 20-80% of an alkylcaprolactam; and, optionally, benzene or cyclohexane. Alcohols, such as methanol, ethanol and propanol are disclosed. See page 1, line 37 of the patent. It is noted that the addition of sodium to the composition will, necessarily, produce a sodium

alkoxide and/or a sodium aminoalkoxide. Franke et al. does not specifically teach the claimed compounds (i.e., a C2-C5 acid amide and/or a C2-C6 diamine).

Wolthers et al. teaches a detoxicant comprising an alkali metal, such as sodium; an amino alcohol, such as aminoethanol; an alcohol, such as butanol; and a strongly polar solvent, such as DMSO.

Hill et al. teaches a decontaminating composition comprising a solvent selected from, e.g., NMP and DMSO.

Fuchs et al. teaches both NMP and DMSO to be known in the chemical art as strongly polar solvents.

It would have been obvious to one of ordinary skill in the art at the time of the invention to substitute the alkylcaprolactam of Franke et al. with NMP (or a C4-C5 lactam) because (1) alkylcaprolactam is a C6 lactam (acid amide); (2) NMP is a C3 lactam; (3) absent unexpected properties, adjacent homologs are generally considered to be obvious, *In re Hass*, 141 F.2d 127, 60 USPQ 548 (CCPA 1944); *In re Henze*, 85 USPQ 261 (CCPA 1950); (4) Wolthers et al. teaches that the solvent of a detoxicant comprising an amino alcohol, an alcohol and an alkali metal need only be strongly polar; (5) DMSO and NMP are both known in the art to be strongly polar; and (6) both NMP and DMSO are both known in the art to be useful as solvents of decontaminating agents. One would have been motivated to substitute the alkylcaprolactam of Franke et al. with NMP because of an expectation of similar success in preparing a detoxicant.

Response to Arguments

Applicant argues that the ranges of each component is so different that the composition leads to different properties even though most ranges are encompassed in the prior art and at least all components meet at the limit.

At the outset, Examiner respectfully reminds the Applicant that a composition and its properties are inseparable. Furthermore, it is obvious to optimize the ranges of a component in a composition where the general range is disclosed.

"Products of identical chemical composition can not have mutual exclusive properties." Any properties exhibited by or benefits from are not given any patentable weight over the prior art provided the composition is inherent. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the disclosed properties are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01. The burden is shifted to the applicant to show that the prior art product does not inherently possess the same properties as the instantly claimed product.

Generally, mere optimization of ranges will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. "When the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimal or workable ranges by routine experimentation. *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955); see also *In re Peterson*, 315 F. 3d at 1330, 65 USPQ 2d at 1382 "The normal desire of scientists or artisans to improve upon what is already generally known

provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages." MPEP 2114.04.

Applicant also argues surprising results for a decontaminating fluid that is mild on the substrate. The burden is shifted to Applicant to show clear and convincing factual evidence of nonobviousness or unexpected results, i.e., side-by-side comparison with the closest prior art in support of nonobviousness for the instant claimed invention over the prior art. For the above stated reasons, said claims are properly rejected under 35 U.S.C.103(a). Therefore, said rejections are adhered to.

Applicant continues to argue that replacing a component of the instant invention with "a polar solvent like DMSO would result in a drastic decrease in decontamination efficiency or, put another way, would require a completely different balancing of the various ingredients of a decontamination liquid in order to make it efficient."

Optimization of the various components of a composition when the general range is disclosed is as discussed above. More importantly, DMSO was merely used in the rejection as a nexus to substitute NMP for DMSO in a detoxicant composition because both are disclosed to be polar solvents. Thus, the motivation is because of the art equivalency of both solvents.

Finally, Applicant argues that the intended use is not concurrent with the instant invention, specifically referring to the referenced invention being far too aggressive to be applied to the skin of a living organism. Examiner respectfully points out the fact that the intended use or preamble of a composition is given little patentable weight.

It is respectfully pointed out that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the

prior art in order to patentably distinguish from each other. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Thus, the intended use of a composition claim will be given no patentable weight.

It is further respectfully pointed out that a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). See MPEP 2111.02.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong S. Chong whose telephone number is (571)-272-8513. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, SREENI PADMANABHAN can be reached on (571)-272-0629. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YSC

SHENGJUN WANG
PRIMARY EXAMINER

Application Number	Application/Control No.	Applicant(s)/Patent under Reexamination	
	10/659,045	FRANKE ET AL.	
	Examiner	Art Unit	
	Yong S. Chong	1617	

Index of Claims

Application/Control No.	Applicant(s)/Patent under Reexamination
10/659,045	FRANKE ET AL.
Examiner	**Art Unit**
Yong S. Chong	1617

√	Rejected	–	(Through numeral) Cancelled	N	Non-Elected	A	Appeal
=	Allowed	÷	Restricted	I	Interference	O	Objected

Claim		Date
Final	Original	5/2/06
	1	√
	2	√
	3	√
	4	√
	5	√
	6	√
	7	√
	8	N
	9	N
	10	N
	11	N
	12	
	13	
	14	
	15	
	16	
	17	
	18	
	19	
	20	
	21	
	22	
	23	
	24	
	25	
	26	
	27	
	28	
	29	
	30	
	31	
	32	
	33	
	34	
	35	
	36	
	37	
	38	
	39	
	40	
	41	
	42	
	43	
	44	
	45	
	46	
	47	
	48	
	49	
	50	

Claim		Date
Final	Original	
	51	
	52	
	53	
	54	
	55	
	56	
	57	
	58	
	59	
	60	
	61	
	62	
	63	
	64	
	65	
	66	
	67	
	68	
	69	
	70	
	71	
	72	
	73	
	74	
	75	
	76	
	77	
	78	
	79	
	80	
	81	
	82	
	83	
	84	
	85	
	86	
	87	
	88	
	89	
	90	
	91	
	92	
	93	
	94	
	95	
	96	
	97	
	98	
	99	
	100	

Claim		Date
Final	Original	
	101	
	102	
	103	
	104	
	105	
	106	
	107	
	108	
	109	
	110	
	111	
	112	
	113	
	114	
	115	
	116	
	117	
	118	
	119	
	120	
	121	
	122	
	123	
	124	
	125	
	126	
	127	
	128	
	129	
	130	
	131	
	132	
	133	
	134	
	135	
	136	
	137	
	138	
	139	
	140	
	141	
	142	
	143	
	144	
	145	
	146	
	147	
	148	
	149	
	150	

Search Notes

Application/Control No.	Applicant(s)/Patent under Reexamination
10/659,045	FRANKE ET AL.
Examiner	**Art Unit**
Yong S. Chong	1617

SEARCHED			
Class	Subclass	Date	Examiner
424	600	5/2/2006	YSC
424	722	5/2/2006	YSC

INTERFERENCE SEARCHED			
Class	Subclass	Date	Examiner

SEARCH NOTES (INCLUDING SEARCH STRATEGY)		
	DATE	EXMR
Inventor (EAST. PALM)	5/2/2006	YSC
Text (EAST, NPL)	5/2/2006	YSC